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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/585,736	07/12/2006	Kazuhiko Kishi	040894-7468	7925
9629 7590 01/05/2009 MORGAN LEWIS & BOCKIUS LLP 1111 PENNSYLVANIA AVENUE NW WASHINGTON, DC 20004				
EXAMINER				
LOW, LINDSAY M				
ART UNIT		PAPER NUMBER		
3721				
MAIL DATE		DELIVERY MODE		
01/05/2009		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/585,736

**Applicant(s)**

KISHI ET AL.

**Examiner**

LINDSAY M. LOW

**Art Unit**

3721

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 30 September 2008.  
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-3 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1-3 is/are rejected.  
7) ☒ Claim(s) 1 is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☒ The drawing(s) filed on 30 September 2008 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☒ Information Disclosure Statement(s) (PTO/5508)  
Paper No(s)/Mail Date 9/24/08  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_  
5) ☐ Notice of Informal Patent Application  
6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. This action is in response to applicant's amendment received on September 30<sup>th</sup>, 2008.

#### ***Information Disclosure Statement***

2. The Information Disclosure Statement (IDS) submitted on September 24<sup>th</sup>, 2008 is acknowledged. The IDS meets the requirements of 37 CFR 1.97 and 1.98. Therefore, the references therein have been considered.

#### ***Claim Objections***

3. Claim 1 is objected to because of the following informalities: the last term in claim 1 should be "staple" instead of "stapler." Appropriate correction is required.

#### ***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 1-3 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The configuration shown in Fig. 13 of the new

drawing, including the driven roller 33 and the drive roller 32, and the reference to them in the amended specification is considered to be new matter, as there is no support for it in the original disclosure.

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1-3 are rejected under 35 U.S.C. 102(b) as being anticipated by McVeigh (4,378,085) for the same reasons set forth in paragraph 10 of the previous office action mailed June 30<sup>th</sup>, 2008.

8. Claims 1-3 are rejected under 35 U.S.C. 102(b) as being anticipated by Kikkawa et al (4,087,034) for the same reasons set forth in paragraph 11 of the previous office action, *supra*.

***Response to Arguments***

9. Applicant's arguments filed September 30<sup>th</sup>, 2008 have been fully considered but they are not persuasive.

Applicant contends that Kikkawa does not have movable clinchers that are disposed to as to be opposed to a striking position of a staple. However, referring to Figs. 12a-12c of Kikkawa, it appears that the movable clinchers 38, 38' are disposed in

such a way that they are opposed to the striking position of the staple. Note that the designated movable clinchers 38, 38' are in the same positions relative to a staple as the applicant's movable clinchers.

Applicant contends that Kikkawa's clincher cam does not have a cam surface engageable with the movable clinchers. However, note that the cams 60, 60' (having the cam surfaces) are integral with the holders 43, 43', which in turn are engageable with the movable clincher 38, 38'. Therefore, the cam surfaces are deemed to be engageable with the movable clinchers.

Applicant contends that Kikkawa's staple legs are not guided into and between the movable and fixed cutters while the staple legs are engaged with the clincher pieces. However, note that the staple legs are still being guided between the cutters when the clinchers engage the staple legs, as the cutters provide a continuous guide (the space between the cutters) for allowing the legs to pass through. Therefore, the staple legs are deemed to be guided between the cutters while the staple legs are engaged with the clincher pieces.

Applicant contends that McVeigh does not show a drive mechanism for driving a stapler that operates a drive link to cut and clinch a staple. However, note that solenoid SOL-3 drives the drive link 56, which in turn drives the clincher cam 55. The drive mechanism disclosed by McVeigh includes the motor, solenoids SOL-1, SOL-2, and SOL-3, and the links, levers and connections in between as shown in Fig. 1. Therefore, the drive link 56 is driven by the same drive mechanism that drives a staple in the stapler.

Applicant contends that McVeigh does not show a clincher cam and cutter cam being integral because there is only one cam face, not two separate ones. However, examiner asserts that claims are given their broadest reasonable interpretation consistent with the specification. In this instance, the claims state that the clincher and cutter cams are "connected together as an integral body." Note that the section of the cam surface 60 that is contacting the sections 50, 51 of clinchers 45, 46 shown in Fig. 4 is considered to be the clincher cam. When drive link 56 is actuated, the sections 50, 51 slide toward the center of the cam 55. The center of cam surface 60 is considered to be the cutter cam. Therefore, the clincher cam and cutter cam are connected together and form an integral body (cam 55).

### ***Conclusion***

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).
11. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to LINDSAY M. LOW whose telephone number is (571)272-1196. The examiner can normally be reached on Monday thru Friday 7:30 to 5:00.

13. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rinaldi Rada can be reached on 571-272-4467. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

14. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/L. M. L./  
Examiner, Art Unit 3721

/Rinaldi I Rada/  
Supervisory Patent Examiner, Art Unit 3721  
12/30/2008